

DOCKETED

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

FILED

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CLERK
U.S. DISTRICT COURT

BALLY MANUFACTURING CORPORATION,)
)
Plaintiff,)
)
v.) CIVIL ACTION
) NO. 78 C 2246
D. GOTTLIEB & CO. and)
WILLIAMS ELECTRONICS, INC.,)
)
Defendants.)

PARTIAL RESPONSE OF DEFENDANT WILLIAMS
ELECTRONICS, INC., TO PLAINTIFF'S
INTERROGATORIES NOS. 1 AND 2

The defendant, Williams Electronics, Inc.,
herein completes its response to plaintiff's Interrogatory
No. 1 and also responds to Interrogatory No. 2.

Interrogatory No. 1

State all facts on which defendant relies in
support of its contentions with respect to:

- (a) its Seventh affirmative defense, Paragraph 20,
of its Answer, that

"20. United States Letters Patent
No. 4,093,232 is invalid and unenforceable
because the applicants for said Letters
Patent and their representatives improperly
failed to completely advise the United
States Patent and Trademark Office of
pertinent, relevant and important of
art known to the applicants and prior
representatives which was material to the
consideration by the United States Patent

and Trademark Office of the application for said Letters Patent whereby the United States Patent and Trademark Office in reliance upon this material omission by the applicants and their representatives issued the said Letters Patent, and, further, had a complete disclosure of such material and relevant prior art been made to the United States Patent and Trademark Office said Letters Patent would not have been issued."

and specifically identify all such "prior art".

- (b) its Eighth affirmative defense, Paragraph 21, of its Answer, that

"21. The applicants and/or their representatives made certain representations to the United States Patent and Trademark Office about the advantages and functional capabilities of the alleged invention of the United States Letters Patent No. 4,093,232 which representations, on information and belief, are not true and based on fact, and the said Office in partial but substantial reliance on these representations improvidently issued said Letters Patent whereby said Letters Patent is invalid."

and specifically identify such "representations", referring to the paper, page and line numbers of the file history of U.S. Patent 4,093,232. (A copy of the file history was previously supplied to the defendant's attorneys.)

- (c) its Ninth affirmative defense, Paragraph 22, of its Answer, that

"22. On information and belief it is alleged that the plaintiff herein is not a true owner of United States Letters Patent No. 4,093,232 and has no right to maintain this action."

and state who defendant contends is the "true owner" of U.S. Patent 4,093,232 and the facts on which defendant relies for that contention.

- (d) its Tenth affirmative defense, Paragraph 23, of its Answer, that

"23. United States Letters Patent No. 4,093,232 is invalid inasmuch as no application was made in the United States Patent and Trademark Office to patent the alleged invention or inventions of such patent as issued prior to one year after they were in public use and/or on sale in the United States whereby the patent is invalid because of "late claiming"."

- (e) its Eleventh affirmative defense, Paragraph 24, of its Answer, that

"24. Plaintiff is not entitled to maintain this action in law or equity inasmuch as actions taken by the plaintiff and/or its authorized agents and representatives prior and subsequent to the issuance of the patent and Williams' reliance upon and consequent change of position because it relied upon those actions whereby the effect of those actions and Williams' reliance thereupon has been to grant an implied license to Williams, or, alternatively, plaintiff has waived its right to maintain an action for the infringement of the patent in suit against Williams."

RESPONSE: (a) Williams' response to this interrogatory is found in its response to Interrogatory 1(f) previously supplied to the plaintiff.

(b) As of this date Williams has not completed its investigation and discovery with respect to this matter. However, on information

and belief it is stated that on page 3 of the specification in lines 26 through 29 statements were made about cost reduction and convenient changes in the basic approach which Williams does not believe were true at the time those statements were made.

The answer to this interrogatory will be supplemented as Williams' investigation and discovery proceed and new information is discovered.

(c) On July 18, 1975 David Nutting & Associates, a partnership, granted an exclusive license under the application of the patent in suit to Mirco Games, Inc., of Phoenix, Arizona. Therefore, it is Williams' position that any subsequent assignment by David Nutting & Associates to any other entity could only have been an assignment of the rights remaining to David Nutting & Associates, and those rights did not include title and the right to maintain this action.

Williams contends that Mirco Games, Inc., is the true owner of United States Patent 4,093,232.

(d) No application was made in the United States Patent and Trademark Office for the claims of the patent in suit until October 19, 1977, and on information and belief Williams contends that parties incorporating the subject matter of those claims were in public use and/or on sale in the United States.

(e) Prior to the issuance of the patent in suit and continuing after its issuance, agents of the plaintiff have purchased games from Williams, which games are presently charged by the plaintiff to infringe the patent in suit. These purchases have been in substantial quantities for the purpose of resale by plaintiff's agents. Williams contends that the effect of these acts has been to grant Williams an implied license under the patent, or, alternatively, have resulted in a waiver or estoppel of plaintiff's right to maintain this action for Williams has relied upon the encouragement to produce the accused machines given by plaintiff's agents.

Interrogatory No. 2

Identify each claim of U.S. Patent 4,093,232 which defendant contends to be invalid under the provisions

of 35 U.S.C. §§102 or 103, and, as to each such claim, identify all of the prior art relied upon in support of such contention.

RESPONSE: As of this date Williams has not completed its investigation and discovery into the validity of the patent in suit under the provisions of 35 U.S.C. §§ 102 or 103. A complete answer to this interrogatory also awaits an identification by the plaintiff of the claims it contends are infringed.

However, the prior art known to Williams and upon which it relies in support of its contention includes the prior art of record in the application for the patent in suit. It also includes the following published articles:

- (1) ELECTRONICS PLAYS THE PINS
ee/systems engineering today
November 1973 - pages 37-41
- (2) MCS-4 MICROCOMPUTER SET
USERS MANUAL
March 1974
Intel Corporation of Santa Clara,
California
- (3) Ease multiplexing and a/d conversion
Electronic Design, April 12, 1973
Pages 84-89
- (4) Process Instruments and Controls Hand-
book
McGraw-Hill 1957
Pages 8-34 to 8-47

The answer to this interrogatory will be supplemented as Williams' investigation and discovery proceed.

Melvin M. Goldenberg
Melvin M. Goldenberg

STATE OF ILLINOIS)
) SS:
COUNTY OF COOK)

I, MELVIN M. GOLDENBERG, do hereby swear that the foregoing answers to parts of Interrogatory No. 1 and Interrogatory No. 2 are provided by me on the basis of my personal knowledge and on the basis of information furnished to me by officers, employees and agents of defendant, Williams Electronics, Inc.

Melvin M. Goldenberg
Melvin M. Goldenberg

Subscribed and sworn to before me this 25th day of September, 1978.

Dolores C. Shanks
Notary Public

